

REMARKS/ARGUMENTS

Status of the Application

In the Advisory action mailed March 14, 2005, the Examiner indicated that the remarks Applicants submitted in response to the Final Office Action mailed on November 24, 2004, did not place the application in condition for allowance. Specifically, the Examiner indicated that the "concept of coating parameters influencing coating application on optical properties when predicting the optical appearance of a coated 3D substrate, etc., needs to be in the claims as well as the specification." Further, the Examiner asserted that there is "nothing in claim 1 to distinguish coating parameters as conditions rather than physical properties."

In the Final Office Action, claims 14 and 15 were allowed; claims 1-4, 7, and 9-13 were rejected; and claims 5, 6, and 8 were objected to. Applicants note that the Examiner indicated that claims 5, 6, and 8 are allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Thus, claims 1-15 are pending.

Rejections Under 35 U.S.C § 103(a)

Claims 1-3 and 9-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara (U.S. Patent No. 5,877,769) in view of Numata et al. (U.S. Patent No. 6,539,325). Applicants respectfully traverse these rejections.

In response to the Advisory Action, Applicants have amended claim 1 to clarify that the coating parameters are conditions under which the test panels are coated (see page 3, lines 32-36, of Applicant's specification for support). Applicants thus respectfully submit that claim 1 reflects the arguments that follow.

Applicants maintain their objections to the Examiner's assertion that Shinohara and Numata et al. are combinable. Further, even if Shinohara and Numata et al. are combinable, these references fail to disclose every element of Applicants' claim 1 invention. For example, in applying Numata et al.'s definition of coating parameters, Applicants believe that the Examiner has misinterpreted coating parameters as they apply to the claim 1 invention. The claim 1 invention covers the influence of coating parameters during coating application on optical properties when predicting the optical appearance of a coated three-dimensional substrate

(generating a computer image) from optical measurements taken on coated test panels (see page 10, line 20 – page 11, line 27 of Applicants' specification).

In arguing that Numata et al. discloses the coating parameters of claim 1 missing in Shinohara, the Examiner asserts that these coating parameters (colorants, pigments, and coating thickness) are equivalent to those covered by Applicants' claim 1 invention. This disclosure of "coating parameters" in Numata et al., however, is wholly unlike that of coating parameters of claim 1 of the present invention. Applicants define the parameters of the coating application as "the conditions under which the test panel is coated" (page 3, lines 32-33, of Applicant's specification). Examples of coating parameters include "the type of atomisation and type of atomiser, atomisation parameters, secondary coating parameters, booth parameters and drying or curing parameters" (page 3, lines 34-36, of Applicants' specification). Examples of each of these parameters are supplied at page 3, line 37 – page 4, line 22 of Applicants' specification. Thus, one of ordinary skill in the art would understand coating parameters according to the present invention to be, for example, the application, drying, and curing of coating, not the physical properties of the coating as disclosed in Numata et al.

Applicants thus respectfully submit that, in addition to previous objections to the combination of Shinohara and Numata et al., the Examiner has failed to establish a *prima facie* case of obviousness in rejecting claim 1 because the combination of Shinohara and Numata et al. fail to disclose every element of Applicants' claimed invention.

Because claims 2-3 and 9-13 are dependent claims, which recite even further limitations to the claim that has already been traversed, Applicants rely upon the arguments presented above in rebuttal to the Examiner's assertion that claims 2-3 and 9-13 are unpatentable.

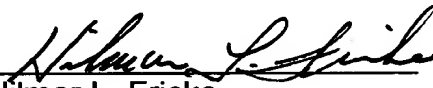
Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara in view of Numata et al. in further view of Rupieper et al. (U.S. Patent No. 5,991,042). Because claim 4 is a dependent claim, which recites even further limitations to claims that have already been traversed, Applicants rely upon the arguments presented above in rebuttal to the Examiner's assertion that claim 4 is unpatentable.

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinohara in view of Numata et al. in further view of allegedly admitted prior art (i.e., the BYK-Gardner Wave-Scan Product). Because claim 7 is a dependent claim, which recites even further limitations to claims that have already been traversed, Applicants rely upon the arguments presented above in rebuttal to the Examiner's assertion that claim 7 is unpatentable.

Summary

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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